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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,061	04/24/2001	Ilya Emil Berchenko	5659-06300/EBM	4091

7590 11/26/2003

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EXAMINER

KRECK, JOHN J

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,061

Applicant(s)

BERCHENKO ET AL.

Examiner

John Kreck

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2424-2426, 2430-2438, 2441-2449, 2457, 2458, 2460, 2461, 5150-5165 and 5167-5212 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 30-32.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 2424-2426, 2430-2438, 2441-2449, 2457, 2458, 2460, 2461, 5150-5165 and 5167-5212.

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DETAILED ACTION

The amendment dated 9/8/03 has been entered.

Claims 2424-2426, 2430-2438, 2441-2449, 2457, 2458, 2460,2461, 5150-5165, and 5167-5212 are pending.

Claims 2424, 5154, and 5196 are generic and allowable over the prior art.

Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 5161-5163, 5184-5190, and 5193, are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2424-2426, 2430-2438, 2441-2449, 2457, 2458, 2460,2461, 5150-5165, and 5167-5212 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of the following copending Applications:

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2. 09/840,937; 09/841,170; 09/841,195; 09/841,283; 09/841,285; 09/841,286; 09/841,288; 09/841,291; 09/841,294; 09/841,297; 09/841,300; 09/841,303; 09/841,306; 09/841,308; 09/841,429; 09/841,431; 09/841,432; 09/841,434; 09/841,438; 09/841,439; 09/841,441; 09/841,443; 09/841,444; 09/841,445; 09/841,449; 09/841,488; 09/841,490; 09/841,495; 09/841,500; 09/841,502; 09/841,638; and 09/841,639. Each of these applications include an independent claim to a process which cannot be practiced without the steps of providing heat; allowing heat to transfer; and producing a mixture. Furthermore, each of these applications include dependent claims which specifically call for less than 1% of the produced mixture is oxygen; controlling the heat such that an average heating rate is less than about 1°C/day; and/or less than 1% of the produced mixture is nitrogen; as called for in the independent claims in this application. It is noted that these applications do not (in the same claims) claim the at least 7 heaters for each production well. This is an obvious modification, as taught by Van Meurs, et al. (U.S. Patent number 4,886,118---see col. 8, line 24), and as detailed in the previous rejections under 103 as set forth in paper 29.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

3. Applicant's arguments filed 9/2/03 have been fully considered. It is noted that applicant has not made any substantive arguments with regards to the double patenting rejections; nor has applicant made any substantive arguments refuting the obviousness of the 7 heaters per production well.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-4177.



John Kreck
Examiner
Art Unit 3673

JJK